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In re Application of: GENNARO, Maria, et al. :
U.S. Application No.: 10/009,384 :
PCT No.: PCT/US00/12197 :
International Filing Date: 04 May 2000 : DECISION ON PETITION
Priority Date: 04 May 1999 : UNDER 37 CFR 1.47(a)
Attorney's Docket No.: 07763-0420011 :
For: SECRETED PROTEINS OF *MYCOBACTERIUM* :
TUBERCULOSIS AND THEIR USE AS :
VACCINES AND DIAGNOSTIC REAGENTS :

This decision is issued in response to applicant's "Petition Under 37 CFR 1.47(b)" filed on 20 August 2002, treated herein as a petition under 37 CFR 1.47(a). Applicant's have paid the required petition fee.

BACKGROUND

On 04 May 2000, applicants filed international application PCT/US00/12197 which claimed a priority date of 04 May 1999 and which designated the United States.

A Demand was filed with the International Preliminary Examining Authority electing the United States prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was thirty months from the priority date, i.e., 04 November 2001.

On 02 November 2001, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of \$50 as the small entity basic national fee.¹

On 20 February 2002, the DO/EO/US mailed a Notification Of Missing Requirements indicating that an executed declaration, the \$65 surcharge for filing the declaration later than thirty months after the priority date, and sequence listing materials.

¹ The \$50 small entity basic national fee is applicable only where a national stage is filed after an International Preliminary Examination Report (IPER) accepting all claims under PCT Article 33 has been issued. Here, the IPER had not been issued at the time the national stage papers were filed. The proper basic national fee was therefore \$355. Deposit Account No. 06-1050 will be charged the \$305 needed to bring the total fee payment to the required amount.

On 20 August 2002, applicants filed a response to the Notification Of Missing Requirements including the required surcharge payment, a partially executed declaration, the petition under 37 CFR 1.47 considered herein (seeking acceptance of the application without the signature of nonsigning inventor Manuel J. Gomez, whom applicants assert cannot be located after diligent effort), sequence listing materials, and the fee for a four month extension of time to respond.

On 25 September 2003, the DO/EO/US mailed a Notification Of A Defective Response indicating that additional sequence listing materials were required.

On 14 October 2003, applicants filed a response to the Notification Of A Defective response.

DISCUSSION

In order for the application to be accepted without the signature of the nonsigning inventor, applicants must submit a grantable petition under 37 CFR 1.47(a).² A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the proper petition fee, (2) a statement of the last known address of the inventor; (3) an oath or declaration executed by the other inventors on their own behalf and on behalf of the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

The petition included the \$130 petition fee, and it sets forth the last known address of the nonsigning inventor. Items (1) and (2) are therefore satisfied.

With respect to item (3), applicants section 409.03(a) of the Manual of Patent Examining Procedure ("MPEP") states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have submitted a declaration containing an unexecuted signature block for the nonsigning inventor and executed by the other inventor. Item (3) is therefore satisfied.

Regarding item (4), the proof required to show that a nonsigning inventor cannot be reached after diligent effort is set forth in section 409.03(d) of the MPEP, which states:

² The petition refers to 37 CFR 1.47(b); however, in a situation where, as here, at least one of the inventors has signed the declaration, 37 CFR 1.47(a) is the applicable provision.

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

...

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail, return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, the petition states that "repeated efforts" to locate the nonsigning inventor were unsuccessful. The petition includes a declaration by the signing inventor Maria Laura Gennaro in which Dr. Gennaro discusses the attempts to locate the nonsigning inventor, Dr. Gomez. The declaration states that Dr Gomez returned to Spain, leaving no forwarding address with Dr. Gennaro or her colleague with whom Dr. Gomez had also worked, and that emails sent to an email address left by Dr. Gomez went unanswered, as did an email addressed to Dr. Gomez' wife. The petition does not set forth in detail any further attempts made to locate the inventor (i.e., internet searches, etc.). Nor is there any evidence that any correspondence was mailed to the inventor's last known address (which would demonstrate if Dr. Gomez left a forwarding address with the post office). Before it can be concluded that the nonsigning inventor cannot be reached after diligent effort, applicants must provide a firsthand statement regarding further efforts made to locate the nonsigning inventor. Accordingly, item (4) is not satisfied.

Based on the foregoing, applicants have not satisfied all the requirements for a grantable petition under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and should include an adequate, firsthand statement setting forth the further efforts made by applicants to locate the nonsigning inventor, as discussed above.

No additional petition fee is required. Failure to file a timely response will result in abandonment of the application.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read 'RMR', is positioned above the typed name of the signatory.

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